



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,319		Hidetoshi Uemura	UEMURA 5	6685
1444	7590	11/04/2003	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C.			SULLIVAN, DANIEL M	
624 NINTH STREET, NW				
SUITE 300			ART UNIT	
WASHINGTON, DC 20001-5303			PAPER NUMBER	
			1636	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/856,319

Applicant(s)

UEMURA ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 20-26,32,33,38,39,42 and 43.

Claim(s) withdrawn from consideration: 11-19,27-31,35-37,40 and 41.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

  
DAVID S. [unclear]  
PRIMARY EXAMINER

Continuation of 2. NOTE: According to the proposed amendment, claims 23 and 32 would be limited to determining the presence or amount of a protein consisting of the amino acid sequence of residues 1-231 of SEQ ID NO: 2 or 4. As even an antibody raised against a protein consisting of residues 1-231 of SEQ ID NO: 2 or 4 would not be able to distinguish proteins consisting of that sequence from proteins comprising that sequence, it is unclear how the method steps set forth would determine the presence or amount of a protein consisting of only residues 1-231 of SEQ ID NO: 2 or 4.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments are predicated on the amendments to the claims filed therewith. As the amendments have not been entered, the arguments are moot. It is noted, however, that the proposed amendments would not overcome rejection of 20, 21, 23, 24, 25, 26, 33, 38 and 39 under 35 U.S.C. 102(b) as anticipated by Reseland et al. and claim 22 under 35 U.S.C. 103(a) as being unpatentable over Reseland et al. in view of Antibodies. Reseland et al. teaches antibodies raised against peptides that are comprised within residues 1-231 of SEQ ID NO: 2 or 4. Therefore, the antibody or Reseland et al. would react with a protein consisting of residues 1-231 of SEQ ID NO: 2 or 4. Furthermore, the proposed amendment to claim 42 does not fully address the grounds of rejection under 35 U.S.C. 112, first paragraph (enablement)..